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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,246

07/20/2007

Jonas Nilsson

47113-5089-00-US

1463

55694 7590 06/08/2009
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EXAMINER

YEE, DEBORAH

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

06/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/584,246	Applicant(s) NILSSON ET AL.	
	Examiner Deborah Yee	Art Unit 1793	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 2-23.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/Deborah Yee/
 Primary Examiner
 Art Unit: 1793

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 2 to 23 do not patentably define over Japanese patent 2001-049399 ("JP-399") alone or in view of US Patent 5,714,114 ("Uehara") because JP-399 discloses martensitic stainless steel alloy having a composition with constituents whose wt% ranges overlap or closely approximate those recited by claims 2 to 23, in particular, prior art lower limit of 0.1 %Cu closely approximates present invention upper limit of <0.1% Cu.

It was argued that JP-399 and Uehara teach a narrow Cu range of 0.1 to 3.0% because of the deleterious effects of both too little and too much Cu. Prior art teaches if Cu is less than 0.1%, a sufficient pitting corrosion resistant effect can not be obtained but if Cu is added in excess of 3.0%, hot workability is deteriorated. Thus, prior art is very specific that one of ordinary skill must avoid Cu below 0.1 wt% which is the amount of Cu claimed in the present claims. In addition, there is no rational basis to one of ordinary skill to have Cu below 0.1 wt% in view of the express teaching away in prior art. As such, there is no basis for a modification to reduce the amount of Cu in JP-399 to include the amount claimed by Applicants.

It is the Examiner's position that the steel of JP-399 contains a lower Cu limit of 0.1 wt% which closely approximate Applicant's claimed Cu range of < 0.1%. Although it was pointed out that JP-399 teaches away from < 0.1% Cu, there still does not appear to be any significant patentable difference between prior art steel containing 0.1 wt% Cu versus present invention steel containing slightly less than 0.1 wt% Cu such as 0.09999 wt% Cu. in absence of evidence to the contrary.

It was submitted that present invention alloy contains a specific combination of Cr, Mo, and N to exhibit increased pitting corrosion resistance without the need of Cu content above 0.1 wt% Cu, but Applicant has not provided any test data to show that pitting corrosion resistance is equivalent or better than prior art steel containing above 0.1 wt% Cu to establish new and unexpected results..

Applicant argued that prior art does not teach PRE equation or any specific steel example that falls within the claimed composition.

It is the Examiner's position that PRE equation is not taught by prior art but it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, see *In re Cooper and Foley* 1943 C.D.357,553 O.G.177. Note prior art steel 8 in table 1 closely meets the claimed composition and when calculated, has a PRE value equal to 25.3 (with the claimed PRE>25) and C:N ratio = 2.7 (within the claimed C:N ratio >2) and in table 2 exhibits a hardness of 59.4 HRC (within the claimed hardness range of >56HRC.). Despite the fact that prior art does not exemplify any specific steel example falling within all the claimed limitations, prior art still teaches the general steel composition having constituents whose wt% ranges overlap or closely approximate those recited in the claims; and such similarities establishes a prima facie case of obviousness.